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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/477,422 01/04/00 SCHAEFFER

J 13DV-13434

EXAMINER

IM52/0312

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ART UNIT

PAPER NUMBER

1775

DATE MAILED:

03/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/477,422

Applicant(s)  
Schaeffer

Examiner  
Bryant Young

Group Art Unit  
1775



☒ Responsive to communication(s) filed on Jan 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-111 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-111 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 14, 15, 19, 20-28, 34-43, 49-55, 60-69, 75-88, and 95-111 drawn to an article, classified in class 428, subclass 615.
- II. Claims 8-13, 16-18, 29-32, 44-48, 56-59, 70-74, and 89-94 drawn to a method, classified in class 427, subclass 252.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed product can be made by another and materially different process such as depositing a ceramic thermal barrier coating in a mold, forming an adherent alumina layer on the ceramic thermal barrier layer, applying an aluminide or platinum-aluminide coating on the alumina layer, and then casting the superalloy substrate in the mold to form the completed article, instead directly applying the coating layers on the superalloy substrate by other processes (e.g., chemical vapor deposition, electron beam physical vapor deposition). While it is noted that claims 14, 15, 19, 20, 95, and 108-111 are product-process-claims and incorporate the same process steps as



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described in process Group II, a product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process such the alternative process described above. See *In re Brown*, 173 USPQ 685, and *In re Fessman*, 180 USPQ 324, for analysis of weight given to process step recitations in product claims.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.


4. A telephone call was made to David Narciso (Reg. No. 35,624) on March 6, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made. A request was made for the restriction requirement to be mailed out.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry to this communication or earlier communications from the Examiner should be directed to Bryant Young, whose telephone number is (703) 306-5480.

  
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March 6, 2001

  
DEBORAH JONES  
SUPERVISOR, PATENT EXAMINER